

Application No.: 09/220,910
Amendment dated April 19, 2007
Office Action dated January 19, 2007

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REMARKS/ARGUMENTS

Claims 42-77 are pending. Claims 42-77 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 42-77 are rejected under 35 U.S.C. §112, first paragraph, and claims 42, 56, 61, 65, 68 and 69 are rejected under 35 U.S.C. §112, second paragraph. Claims 42-77 are rejected under 35 U.S.C. §102(e) as being anticipated by Thornton et al., U.S. Patent No. 6,240,429 B1 ("Thornton"). Claims 42 is amended to clarify aspects of the present invention.

With regard to the §112, second paragraph rejection, Applicant submits one skilled in the art would recognize and know how to practice the claimed invention using an "un-selected indicator" upon reading the specification. In the present application, the described embodiments clearly involve a system and method for processing the contents of a primary document to locate an indicator that is merely present (i.e., un-selected by a user) in the primary document, identifying a secondary document associated with the un-selected indicator, and encapsulating the secondary document within the primary document. The Office Action's interpretation that the term refers to any parameter or value provided by the method and apparatus in the prior art is contrary to the understanding of one of ordinary skill in the art, and is unnecessary and improper. Therefore, Applicant submits claims 42, 56, 61, 65, 68 and 69 in their present form overcome all 35 U.S.C. §112, second paragraph issues and are allowable in their present form.

With regard to the §101 rejections, Figure 3 (*see* Figure 3 and its description beginning on page 5 of the Specification), for example, describes an embodiment for

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processing e-mail messages in accordance with the present invention. Applicants submit one of ordinary skill in the art would understand the subject matter of claims 42-77 (as amended) are directed to a useful, concrete and tangible result. The current §101 rejections should be withdrawn.

With regard to the §112, first paragraph rejection, Applicants submit the subject matter, including the utility of same, is described in the Specification (*see e.g.*, Figure 3 of the Specification), and would be easily understood by one of ordinary skill in the art. The current §112, first paragraph rejection should be withdrawn as well.

Applicant submits the cited reference Thornton does not teach or suggest at least “[a] method comprising ... attaching said secondary document to said primary document to encapsulate said secondary document within said primary document” (*e.g.*, as described in claim 1).

The Office Action asserts Thornton teaches attaching a secondary document to said primary document to encapsulate a secondary document within a primary document (citing link 32 and column 11, lines 39-57). *See* Office Action dated 1/19/2007, paragraph 7. Applicant disagrees.

The cited section (including the reference to link 32) states:

Reference documents 20b-2c are configured to interact with base document 20a. Both base documents and reference documents can also hold static properties 22 and/or active properties 24. When principals 2,3 access base document 20a for the first time, corresponding reference documents 20b-c are created under kernels 18b-18c, respectively. Reference documents 20b-c store links 28 and 30 to unambiguously identify their base document 20a. In particular, in the present invention each base document is stored with a document ID which is a unique identifier for that document. When reference documents 20b-2c are created, they generate links to the specific document ID of their base document. Alternatively, if principal n references reference document 2c, reference document 20n is

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created with a link 32 to reference document 20c of Principal 3. By this link principal n will be able to view (i.e. its document handle) the public properties principal 3 has attached to its reference document 2c as well as the base properties and public reference properties of base document 20a. This illustrates the concept of chaining.

The cited section discusses base documents (e.g., 20a), and the creation of reference documents with respect to the base documents (e.g., 20b-c). The reference documents *store* links 32 to identify their base documents. The links 32 identify the base documents, and when the reference documents 20b-c are created, they *link* to the base document 20a. Similarly, if a second reference document 20n is created with reference to first reference document 20b (or 20c), another link 32 is placed to *link* the second reference document to the first reference document. In this way, the documents are *linked* or "chained" together.

Applicant submits the process of merely inserting a link of a base document into a reference document and chaining the two documents together is not the same as "attaching said secondary document to said primary document to encapsulate said secondary document within said primary document" as described in embodiments of the present invention (e.g., claim 42). In order to support a proper rejection to the claim 42, the Thornton reference must teach or suggest at least this limitation of claim 42. For at least the reasons discussed above, it fails to do so.

Since each and every limitation of claim 1 is not taught in the cited reference, the current §102(e) rejection is lacking and should be withdrawn. Applicant submits claim 42 is presently allowable. Claims 56, 61, 65, 68, and 69, containing similar allowable

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limitations, are allowable for similar reasons. Claims 43-55, 57-60, 62-64, 66-67, and 70-77 are allowable for depending from allowable base claims.

For at least the above reasons, Applicant respectfully submits that the present case is in condition for allowance and respectfully requests that the Examiner issue a notice of allowance.

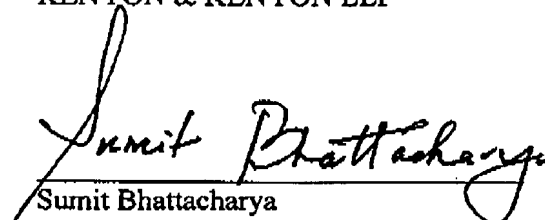
The Office is hereby authorized to charge any fees determined to be necessary under 37 C.F.R. §1.16 or §1.17 or credit any overpayment to Kenyon & Kenyon LLP Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at (408) 975-7500 to discuss any matter concerning this application.

Respectfully submitted,

KENYON & KENYON LLP

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